

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 9, 17, 43, 44 and 45 have been amended. Claims 1, 2, 5-10, 13-18, 21-26, 28-32, 34-38 and 40-51 are pending.

Rejection of the claims

In the Office Action, independent claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0162842 ("Ono").

Claim 1 recites:

1. A method performed by a computer system, comprising:
storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper;
at a first location within the electronic version, detecting a reference to a second location that is exclusive of the first location, wherein the detected reference at the first location is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
in response to the detected reference at the first location, embedding a hyperlink within the detected reference at the first location, wherein the hyperlink is selectable at the first location by a user to cause displaying of the second location on the display device instead of the first location on the display device.

In MPEP § 2131, the PTO provides that:

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, to sustain a rejection of claim 1, Ono must contain all of the above-recited elements in claim 1. However, Ono fails to teach the combination of elements in claim 1. In fact, Ono teaches away from such a combination.

For example, Ono detects a keyword in a **KWIC** document, but Ono embeds a clickable link within an **abstract** document (whose likeness is different from the KWIC document's likeness). In Ono, FIG. 12 shows an example of the abstract document, and FIG. 14 shows an example of the KWIC document. In the last sentence of paragraph [0111], Ono states, "What is presented when the user reads the abstract document and refers to the original page via the link embedded within the abstract document is the KWIC document." In paragraph [0156], Ono states, "'Internet' and 'Intranet' indicated by bold letters in the display in FIG. 12 are clickable and links *to* corresponding portion of the KWIC document are embedded therein" (emphasis added). Accordingly, in the last sentence of paragraph [0156], Ono states, "That is, the display is changed as shown in FIG. 14." Therefore, by embedding its clickable link within the abstract document (whose likeness is different from the KWIC document's likeness), Ono fails to embed its clickable link at the location where Ono detects the keyword in the KWIC document.

By comparison, claim 1 requires: *at a first location* within the electronic version, detecting a reference to a second location that is exclusive of the first location; and, in response to the detected reference at the first location, *embedding a hyperlink within the detected reference at the first location*, wherein the hyperlink is *selectable at the first location* by a user to cause displaying of the second location on the display device instead of the first location on the display device.

Therefore, by embedding its clickable link within the abstract document (whose likeness is different from the KWIC document's likeness), Ono clearly teaches away from claim 1, because Ono fails to embed its clickable link at the location where Ono detects the keyword in the KWIC document.

Accordingly, Ono fails to support a rejection of claim 1 under 35 U.S.C. § 102(e). In relation to claims 9, 17, 43, 44 and 45, Ono is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the

applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Ono is defective in establishing a prima facie case of obviousness. As between Ono and Applicant's specification, only Applicant's specification teaches the combination of elements in claim 1. In fact, Ono teaches away from such a combination. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to claims 9, 17, 43, 44 and 45, Ono is likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of claims 1, 9, 17, 43, 44 and 45 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 9, 17, 43, 44 and 45.

Dependent claims 2, 5-8, 25, 26, 28-30, 46 and 47 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 10, 13-16, 31, 32, 34-36, 48 and 49 depend from and further limit claim 9 and therefore are allowable.

Dependent claims 18, 21-24, 37, 38, 40-42, 50 and 51 depend from and further limit claim 17 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 5-10, 13-18, 21-26, 28-32, 34-38 and 40-51 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael A. Davis, Jr.", with a stylized flourish at the end.

Michael A. Davis, Jr.

Registration No. 35,488

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Davis Law Group, P.C.

6836 Bee Caves Road

Suite 220

Austin, TX 78746

Telephone 512-306-8324

Facsimile 512-306-8374

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